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EXAMINER

PADMANABHAN, KAVITA

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

Status of Claims

1. Claims 1-23, 48-70, 95, and 96 are pending.
2. Claims 1, 17, 48, 64, 95, and 96 have been amended.
3. Claims 1-23, 48-70, 95, and 96 are rejected.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-23, 48-70, 95, and 96** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “determining, at the first hand-held device”, as recited in independent claims 1, 48, and 95 and the limitation “determining, at the hand-held device”, as recited in independent claim 96, do not appear to be supported by the applicant’s original disclosure, nor has the applicant directed the examiner to portions of the specification that might contain the needed support. The dependent claims are rejected in view of their dependence on the rejected base claims.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claim 95** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In regards to **claim 95**, the system claimed is not directed to statutory subject matter, in that it appears that the means recited include embodiments that consist purely of software, which is not statutory. This assertion is evidenced by claim 48, which recites, in part, a system comprising program code, wherein the program code causes the processor to perform the limitations claimed in claim 95. Therefore, the means of claim 95 could clearly be program code, or software. Claim 95 is therefore not limited to statutory subject matter.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 1-3, 6-16, 19-22, 48-50, 53-63, 66-69, 95, and 96** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** (US 6,269,369).

In regards to **claim 1**, **Robertson** teaches a method, comprising:

- receiving data at a first hand-held device (**Robertson; col. 4, lines 56-60 – clients may be hand-held devices, such as Palm Pilots; col. 13, lines 18-23 – “if a first user lives in Boston but is traveling to New York on March 5, then the first user will be informed if any contacts will be crossing paths on that day in either city”; Fig. 14**);
- determining a match found between the data received at the first hand-held device and data held by a second hand-held device within a short-range communication range of the first hand-held device (**Robertson; Fig. 14; col. 16, Appendix A – shows matching**);
- creating a log entry in accordance with the match (**Robertson; col. 20, Appendix I – a list constitutes a log of entries**); and

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- providing a socially-relevant recommendation to a user of the first hand-held device relating to the data received at the first hand-held device after one or more criteria have been met, wherein the criteria include a specification of at least a predefined number of matches between the data received at the first hand-held device and data held by one or more other hand-held devices encountered within the short-range communication range of the first hand-held device (**Robertson; Fig. 8; col. 13, lines 18-23 - “if a first user lives in Boston but is traveling to New York on March 5, then the first user will be informed if any contacts will be crossing paths on that day in either city” – constitutes a socially-relevant recommendation after one or more criteria are met; col. 14, lines 27-61; Fig. 12).**

Robertson does not expressly teach the determining a match being performed *at the first hand-held device*.

However, **Robertson** does teach the hand-held devices including their own databases and their own software, which can perform data management and synchronization functions (**Robertson; col. 4, lines 57-60; col. 5, lines 42-65).**

Therefore, since each hand-held device includes its own database that can be synchronized with the server database and each hand-held device also includes its own software, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to program the first hand-held device to carry out the function of determining a match, in order to ease the workload on the server and so that the server need not be consulted as often.

In regards to **claim 2**, **Robertson** teaches the method of claim 1, wherein the data received at the first hand-held device includes at least an identifier for data held by the second hand-held device (**Robertson; col. 10, lines 54-61; col. 11, lines 50-59; Fig. 7; col. 14, lines 27-61; Fig. 12**).

In regards to **claim 3**, **Robertson** teaches the method of claim 2, wherein the identifier is a unique identifier (**Robertson; col. 16, lines 7-21**).

In regards to **claim 6**, **Robertson** teaches the method of claim 2, wherein the data received at the first hand-held device includes a data element held by the second hand-held device (**Robertson; col. 4, lines 56-59; col. 11, lines 50-59; col. 14, lines 27-61; col. 16, lines 7-21**).

In regards to **claim 7**, **Robertson** teaches the method of claim 6, wherein the data element is a phone number (**Robertson; col. 11, lines 50-59; Fig. 7**).

In regards to **claim 8**, **Robertson** teaches the method of claim 6, wherein the data element is a universal resource locator (**Robertson; col. 16, lines 56-57**).

In regards to **claim 9**, **Robertson** teaches the method of claim 1, wherein the data received at the first hand-held device is not browsable by the user (**Robertson; col. 11, lines 50-**

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59; col. 16, lines 56-57 – for example, although not displayed/”browsable”, address id must have been sent in order to update the local PIM data).

In regards to **claim 10, Robertson** teaches the method of claim 1, further comprising determining if the user already possesses data relating to the socially-relevant recommendation **(Robertson; Fig. 14).**

In regards to **claim 11, Robertson** teaches the method of claim 1, wherein the recommendation is provided at a particular period of time after the one or more criteria have been met **(Robertson; col. 11, lines 28-32; col. 14, lines 27-30).**

In regards to **claim 12, Robertson** teaches the method of claim 1, wherein the recommendation is provided at a particular time of day after one or more criteria have been met **(Robertson; col. 11, lines 28-32; col. 14, lines 27-30 – “particular time of day” is a broad limitation; since a recommendation is clearly provided at a particular time, that time at which the recommendation is provided is interpreted to be “the particular time of day”).**

In regards to **claim 13, Robertson** teaches the method of claim 1, wherein the recommendation is provided after the user performs an operation with the first hand-held device **(Robertson; col. 5, lines 5-19; Fig. 7; Fig. 12).**

In regards to **claim 14, Robertson** teaches the method of claim 1, wherein the recommendation suggests to the user addition of data relating to the data received at the first hand-held device (**Robertson; Fig. 8**).

In regards to **claim 15, Robertson** teaches the method of claim 14, wherein the data suggested for addition is held by the second hand-held device (**Robertson; col. 10, lines 10-16; Fig. 14; col. 16, lines 7-21**).

In regards to **claim 16, Robertson** teaches the method of claim 1, wherein the first hand-held device employs short-range communication in communicating with the second hand-held device (**Robertson; Fig. 14**).

In regards to **claim 19, Robertson** teaches the method of claim 1, wherein one or more criteria provide for weighting of log entries (**Robertson; col. 20, Appendix I – certain matches/log entries are given higher/lower weight depending on permissions**).

In regards to **claim 20, Robertson** teaches the method of claim 1, wherein the recommendation is not provided after expiration of a validity period (**Robertson; col. 11, lines 28-32**).

In regards to **claim 21, Robertson** teaches the method of claim 1, wherein the data received at the first hand-held device is updated (**Robertson; col. 4, lines 42-45; Fig. 11**).

In regards to **claim 22**, **Robertson** teaches the method of claim 1, wherein the user is directed to a source for information regarding data suggested by the recommendation (**Robertson; Fig. 8; Fig. 11; Fig. 12 – the people listed are sources of information; col. 16, lines 56-57**).

Claims 48-50, 53-63, and 66-69 are rejected with the same rationale given for claims 1-3, 6-16, and 19-22, respectively.

Claims 95 and 96 are each rejected with the same rationale given for claim 1.

11. **Claims 17, 23, 64, and 70** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Tsou et al.** (US 2002/0184089, hereinafter “**Tsou**”).

In regards to **claim 17**, **Robertson** teaches the method of claim 16.

Robertson does not expressly teach employing IEEE 802.15.1 for the short-range communications.

Tsou teaches Bluetooth as an exemplary wireless communication protocol (**Tsou; par [0032]; par [0039]**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson** using the Bluetooth communication protocol, as taught by **Tsou**, to send and receive information between wireless devices (**Tsou; par [0032]; par [0039]**).

In regards to **claim 23**, **Robertson** teaches the method of claim 1.

Robertson does not expressly teach an advertiser learning if the user complied with the recommendation.

Tsou teaches providing a wireless user with promotional advertisements and providing the advertiser with statistics regarding the effectiveness of those advertisements (**Tsou; par [0016] – par [0018]**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson, whereby users would be notified of promotional offers/recommendations from advertisers, and the advertisers would be notified of whether the users clicked on, i.e. complied with, the recommended promotions (**Tsou; par [0049]; par [0052]**).

Claims 64 and 70 are rejected with the same rationale given for claims 17 and 23, respectively.

12. **Claims 18 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Young et al.** (US 7,024,690, hereinafter "Young").

In regards to **claim 18**, **Robertson** teaches the method of claim 1.

Robertson does not expressly teach employing a one-way hash of a unique identifier associated with the second hand-held device in creating the log entry.

Young teaches employing one-way hashes of identifiers to enhance security of wireless communications (**Young; Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson, whereby the communication of data between the user hand-held devices is made more secure by employing one-way hashing, as taught by Young (**Young; Abstract**). The data transmitted to/from the wireless clients of Robertson, which is then used in determining matches/log entries, would thereby be more trusted.

Claim 65 is rejected with the same rationale given for claim 18.

13. **Claims 4 and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Bieganski et al.** (US 6,412,012, hereinafter "Bieganski").

In regards to **claim 4**, **Robertson** teaches the method of claim 2.

Robertson does not expressly teach the identifier being an international standard book number.

Bieganski teaches recommending books to users via international standard book number (ISBNs) based on matches with books already selected by the user (**Bieganski; col. 18, line 50 – col. 19, line 11**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson, whereby ISBNs are sent to a user to

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recommend books that may be of interest to the user (**Bieganski; col. 18, line 50 – col. 19, line 11**).

Claim 51 is rejected with the same rationale given for claim 4.

14. **Claims 5 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Spooner** (US 2005/0034099).

In regards to **claim 5**, **Robertson** teaches the method of claim 2.

Robertson does not expressly teach the identifier being an international mobile equipment identity identifier.

Spooner teaches the use of a session specific identifier within a Symbian OS (**Spooner; par [0023]**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson** using a Symbian identifier, as taught by **Spooner**, in order to check whether users or devices have the necessary rights to communicate (**Spooner; par [0023]**).

Claim 52 is rejected with the same rationale given for claim 5.

Response to Amendment

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15. Applicant's amendments filed 12/20/07 with respect to the 35 USC 112, 1st and 2nd paragraph rejections have been fully considered. The previous rejections have been withdrawn accordingly. However, the amendments to the claims have precipitated new 35 USC 112, 1st paragraph rejections, as noted above.

Response to Arguments

16. Applicant's arguments filed 12/20/07 with respect to the 35 USC 101 rejections have been fully considered but they are not persuasive.

Applicant argues that claim 48 reciting program code for performing the limitations claimed in claim 95 does not indicate that claim 95 is not statutory. To clarify, the examiner asserts that claim 95 is not statutory because it is not limited to statutory embodiments. Instead, the means recited could consist purely of software program code. Claim 48 was merely mentioned as further evidence that the means of claim 95 could indeed be software per se, but that was not the basis of the rejection. The rejection of claim 95 is maintained.

17. Applicant's arguments filed 12/20/07 with respect to the prior art rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is (571)272-8352. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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March 18, 2008

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